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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,203	08/22/2005	Christopher Nutbeam	07812.0050-00	8623
22852	7590	12/19/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER ABU ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			12/19/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,203

**Applicant(s)**

NUTBEEM ET AL.

**Examiner**

SHUANGYI ABU ALI

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/16/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-69 is/are pending in the application.
- 4a) Of the above claim(s) 61-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 15-69 remain for examination. Claims 61-69 are withdrawn.

### ***Claim Rejections - 35 USC § 103***

The rejection of claims 15-43, 47-58 and 60 under 35 U.S.C. 103(a) as being unpatentable over WO 00/66510 as generally set forth in the previous office action mailed 07/21/2008 stands.

The rejection of claims 44-46 and 59 under 35 U.S.C. 103(a) as being unpatentable over WO 00/66510, as applied above and further in view of U. S. Patent No. 5,833,747 as generally set forth in the previous office action mailed 07/21/2008 stands.

The rejection of claims 15, 30-37, 39-41, 44-46, 51-60 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No. 5,833,747, in view of WO 02/16511 as generally set forth in the previous office action mailed 07/21/2008 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

### ***Response to Arguments***

Applicant's arguments, see section IV, filed 09/16/2008, with respect to the rejection of double patenting have been fully considered and are persuasive. The

rejection of claims 15, 16, 28, 41, 44-46, 51 and 52 under non-statutory, obviousness-type double patenting has been withdrawn.

Applicant's arguments filed 09/16/2008 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 15-60 under 35 U.S.C. 103(a) as indicated in the previous Office Action stand.

Regarding Lyons, the applicant argues that Lyons does not disclose "overlapping ranges". In response, it is noted that Lyons discloses a composition comprising PCC composition, such as aragonite or rhombohedral, and a kaolin composition, which has a shape factor of less than 25 and a steepness of greater than 38. (Page 5, 8 and 18). "About" permits some tolerance.

The applicant argues that Lyons teaches away from the instant application. The Examiner respectfully submits that a reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Regarding Bleakley and Johns, applicant argues that Bleakley is silent about the kaolin having a shape factor of 30. The Examiner respectfully submits that Bleakley discloses a composition comprising a PCC (aragonitic) composition and a kaolin

(encompasses kaolinite) composition, where the PCC has a defined sizes. The Kaolin composition has an aspect ratio of larger than 30. The shape factor is the aspect ratio of the kaolin. Furthermore, Bleakley disclose of using platy kaolin. Applicant's admission discloses that it is known in the art that the platy kaolin has a shape factor of more than 25 (page 6, line 11-12).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case both Bleakly and Johns are drawn to kaolin product, and Johns discloses that the combination of the defined values of steepness factor and shape factor give, in a paper made from the kaolin product, a beneficially enhanced combination of brightness and high porosity and thereby enhanced printability (WO'511, page 8). It is clear that both references are directed to kaolin products and can be properly combined and applicants show no evidence otherwise. In view of this (see clear reasons defined in the previous office action) the examiner has established a clear prima facie case of obviousness and burden is shifted to applicants to establish clear proof as to why one skilled in the art would not or could not, under any circumstances, be motivated to make the combination as claimed (i.e. choose the

steepness factor defined by the WO reference for the kaolin of the primary reference). In addition, it is to be noted that all kaolin's must have a steepness factor associated therewith and the skilled artisan would have clearly known to use a steepness factor that is known in the art of kaolin products, wherein said steepness factor is known to provide beneficial results, as is the case in the teaching of the WO reference (see previous action).

Applicant argues that neither Bleakley nor Johns expressly disclose the use of the rhombohedral calcium carbonate. The Examiner respectfully submits that the independent claim recites that aragonitic calcium carbonate can be used in the composition and is not limited to the form argued.

Regarding Lyons and Bleakley, since the ground for rejection of Lyons stands as set forth in the previous office action and in previous paragraph in this office action, the rejections of Lyons and Bleakley are proper and stand.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sa

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793